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08/846,017

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/846,017	04/25/97	CECH	T UTC-02824
WILLIAM M SMITH TOWNSEND AND ROWNSEND AND CREW TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO CA 94111-3834			EXAMINER SCHEINER, T ART UNIT PAPER NUMBER 1642 8 DATE MAILED: 04/03/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-26 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1642

DETAILED ACTION

Claims 21-26 have been added by preliminary amendment. Claims 1-26 are pending in the application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 21-26, drawn to telomerase polypeptides, polynucleotides encoding telomerase, hybridization probes, hybridization assays, methods of making telomerase polypeptides, anti-sense polynucleotides and pharmaceuticals containing anti-sense polynucleotides, etc., classified in class 435, subclass 6; class 514, subclass 44; and class 536, subclass 23.2.
- II. Claims 18-20, drawn to antibodies specific for telomerase, methods of detecting telomerase using the antibodies, and pharmaceuticals containing the antibodies, classified in class 435, subclass 7.4 and class 530, subclass 388.26.

Groups I and II represent separate and distinct inventions because the polypeptides and polynucleotides of Group I are chemically and functionally distinct from the antibodies of Group II, and they are made by, and used in different methods. Moreover, the search required for one group is not required for the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

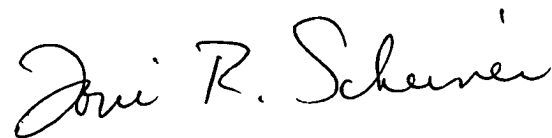
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A telephone call was made to Randolph Apple on March 17, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toni R. Scheiner whose telephone number is (703) 308-3983.

3/30/98



TONI R. SCHEINER
PRIMARY EXAMINER
GROUP 1800